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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/740,679

12/19/2000

J. Stuart Cumming

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ORRICK, HERRINGTON & SUTCLIFFE, LLP

IP PROSECUTION DEPARTMENT

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SUITE 1600

IRVINE, CA 92614-2558

EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

05/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/740,679

**Applicant(s)**

CUMMING, J. STUART

**Examiner**

Paul B. Prebille

**Art Unit**

3774

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 53-102 and 104-124 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-57,59,61,63,72-74,77,80,85,86,90,91,93-95,99-102 and 104-124 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are 58,60,62,64-71,75,76,78,79,81-84,87-89,92 and 96-98.

***Election/Restrictions***

Claims 58, 60, 62, 64-71, 75, 76, 78, 79, 81-84, 87-89, 92, and 96-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2002. Claim 65 is dependent upon a withdrawn base claim so it is withdrawn even though the Applicant argued that it was drawn to the elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90-91, 93-95, 99-102, and 104-124 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new language "straight groove across each plate haptic tangential to the optic" lacks original support. The Applicant is reminded that an RCE cannot be used a means to enter new matter only continuation filed under Rule 53 as continuation-in-part applications. It is noted that the language "tangential" is used on paragraphs 110 and 128 of the corresponding publication to this file but it is used in a different fashion and to different species to the presently elected species of Figure 18.

In particular, "tangential" requires that the groove touch the curve of the optic; see MSN Encarta online dictionary for "tangent" located at the website address of <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861718287>. It is not clear from Figure 18 that this is the case and even the specification, for other species and/or features utilizes the modifier "virtually" or "generally" therewith; see paragraphs 110 and 128 of corresponding publication US 2001/0001836. For these reasons, the Examiner asserts that the claim language lacks original support.

### ***Specification***

The amendment filed April 2, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment made to page 33 introduces new matter into the specification. It is not clear that any or all figures have a straight and tangential groove with respect to the optic when "tangential" is understood in the manner explained in the previous paragraph.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80, 85, 86, 107, 110-115, and 117-124 are rejected under 35 U.S.C. 102(b) as being anticipated by Reuss et al (US 4,664,665). Reuss anticipates the claim language where:

- the optic as claimed is the primary portion (32) of Reuss;
- a biconvex optic is taught on column 1, lines 32-39 and column 6, lines 51-60;
- the groove as claimed is groove (66) of Reuss;
- the haptic as claimed is secondary portion (34) or (36);
- the lens is capable of movement because it is foldable and has the same design as claimed; see Figures 1 to 10 and column 3, line 66 et seq.

### ***Response to Arguments***

Applicant's arguments filed April 2, 2008 have been fully considered but they are not persuasive.

In response to the traversal of the Section 112, first paragraph rejection that there is support from the drawings, the Examiner asserts that there is no clear support from the figures because the haptics of Figure 2 are clearly different in shape from the haptics in Figures 16 and 18 in that the lateral edges are not parallel to each other in Figure 2 as they are in Figures 16 and 18. Moreover, the original language of the specification on paragraph 110 "generally tangential" was related to the orientation of the haptics with respect to the optic (of a different species) not the orientation of the grooves as now claimed; see the publication of the application US 2001/0001836. Furthermore, original paragraph 128 utilizes the term "virtually" to modify "tangential"

when discussing the groove orientation of a different species to the one elected herein. For these reasons, the Examiner has concluded that the claim language and the specification lacks clear original support.

With regard to the Section 102 rejection, the Applicant's Representative argues that the Examiner has "misinterpreted the structure of the lens of Reuss." However, the Examiner asserts that the Applicant's Representative has given the term "haptic" an unreasonably narrow interpretation. In particular, "haptic" is defined as "tactile" by Dorland's Illustrated Medical Dictionary online at the web address of: [http://www.mercksource.com/pp/us/cns/cns\\_hl\\_dorlands\\_split.jsp?pg=/ppdocs/us/comm/on/dorlands/dorland/four/000047159.htm](http://www.mercksource.com/pp/us/cns/cns_hl_dorlands_split.jsp?pg=/ppdocs/us/comm/on/dorlands/dorland/four/000047159.htm). Also, Merriam-Webster Online defines "haptic" as "relating to or based on the sense of touch" see the web address of <http://www.merriam-webster.com/cgi-bin/dictionary?book=Dictionary&va=haptic>. Since the secondary portions are at least capable of touching something, these portions are "haptics" to the extent that this term can be give patentable weight. Furthermore, the Examiner asserts that the secondary portions are clearly plate haptics to the extent that they are flat, and thus, would not act as lenses to focus light. In other words, the secondary portions have all the properties that plate haptics do. The mere fact that the secondary portions are not called haptics does not mean that they are not haptics in both structure and function.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilib whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774